

BS00097 CIP 1

U.S. Application No. 10/802,085 Examiner Chow, Art Unit 2645  
Submission of Amendment with RCE in Response to September 7, 2005 Final Office Action

### REMARKS

In response to the Final Office Action dated September 7, 2005, the Assignee respectfully requests reconsideration based on the above amendments and the following remarks.

The United States Patent and Trademark Office (the "Office") finally rejected claims 1, 3, 5-6, 8-9, 11-13, 15-17, and 21-22 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,768,789 to Wilk. Claims 2 and 10 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Wilk*. Claim 4 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Wilk*. Claims 18-20 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Wilk* in view of U.S. Patent 6,666,376 to Ericson. The Assignee shows, however, that the pending claims are neither anticipated, nor obviated, by the cited documents. The Assignee, then, respectively submits that the pending claims are ready for allowance.

### Rejection of Claims Under 35 U.S.C. § 102

The Office finally rejected claims 1, 3, 5-6, 8-9, 11-13, 15-17, and 21-22 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,768,789 to Wilk. A claim is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P."). As the Assignee shows, however, the pending claims distinguish over *Wilk*. The reference to *Wilk* does not anticipate the claims, so the Assignee respectfully requests allowance of these claims.

Independent claims 1, 9, 21, and 22 are not anticipated. The independent claims all recite features not disclosed by *Wilk*. Independent claim 1, for example, recites "*accessing a database of pre-created text messages, the database storing a pre-created text message having a common association between the receiving party and the originating party*" (emphasis added). Claim 1 also recites "*communicating the pre-created text message to an Internet Protocol address*

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associated with the originating party" (emphasis added). A "clean" version of amended claim 1 is reproduced below, and independent claims 9, 21, and 22 recite similar features.

[c01] (Currently Amended) A method of providing communications services, comprising the steps of:

receiving caller identification information identifying a call from an originating party to a receiving party;

accessing a database of pre-created text messages, the database storing a pre-created text message having a common association between the receiving party and the originating party; and

communicating the pre-created text message to an Internet Protocol address associated with the originating party.

*Wilk* does not anticipate such features. *Wilk*, in contradistinction, sends a prerecorded outgoing voice message to the calling party. As *Wilk* explains, the callee prerecords one or more voice messages. See U.S. Patent 6,768,789 to *Wilk* (Jul. 27, 2004) at column 4, lines 18-25. When a call is received, the callee makes a selection and the selected message is then "played to the caller." *Id.* at column 4, lines 57-62. *Wilk* does not "communicat[e] the pre-created text message to an Internet Protocol address associated with the originating party," as the independent claims recite.

*Wilk* does mention text-to-speech messages. *Wilk* explains that the callee may prepare a text message for the calling party. See *id.* at column 7, lines 48-50. The text message, however, is then converted to speech "using a text-to-speech generator." *Id.* at column 7, lines 49-51. So, *Wilk* still communicates a voice message to the calling party. *Wilk* does not "communicat[e] the pre-created text message to an Internet Protocol address associated with the originating party." Because *Wilk* is silent to such features, *Wilk* cannot anticipate the pending claims. Examiner Chow is respectfully requested to remove the § 102 rejections of the claims.

#### **Rejection of Claims Under 35 U.S.C. § 103**

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Claims 2 and 10 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Wilk*. Claim 4 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Wilk*. Claims 18-20 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Wilk* in view of U.S. Patent 6,666,376 to Ericson. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P."). Here, however, the proposed combinations all fail to teach or suggest all the features of the independent claims. The *prima facie* cases for obviousness, then, must fail.

**1. Claims 2 & 10 are not Obvious**

Claims 2 and 10 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Wilk*. Claims 2 and 10, however, depend on their respective base claims and, thus, incorporate the same distinguishing features. Examiner Chow is thus respectfully requested to remove the § 103 rejections.

**2. Claim 4 is not Obvious**

Claim 4 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Wilk*. Claim 4, however, depends from independent claim 1 and, thus, incorporates the same distinguishing features. Examiner Chow is thus respectfully requested to remove the § 103 rejection.

**3. Claims 18-20 are not Obvious**

Claims 18-20 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Wilk* in view of U.S. Patent 6,666,376 to Ericson. Claims 18-20, however, depend on their respective

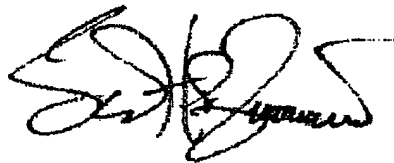
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base claims and, thus, incorporate the same distinguishing features. Examiner Chow is thus respectfully requested to remove the § 103 rejections.

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If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or [scott@wzpatents.com](mailto:scott@wzpatents.com).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Scott P. Zimmerman', with a stylized flourish at the end.

Scott P. Zimmerman  
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